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09/903,284	07/11/2001	Ellen Barbara	CITI0230	9290
27510	7590	11/28/2006	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			OYEBISI, OJO O	
			ART UNIT	PAPER NUMBER
			3692	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,284

Applicant(s)

BARBARA ET AL.

Examiner

OJO O. OYEBISI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-44 and 50-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-44 and 50-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on 08/16/06, PROSECUTION IS HEREBY REOPENED. The finality of the last office action is hereby withdrawn; to avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35-38 are rejected under 35 U.S.C. 112, second paragraph. Claim 35 recites the limitation "the system of claim 1" in the preamble. However, claim 1 is a method claim, thus there is insufficient antecedent basis for this limitation in the claim. Claims 36-38 are rejected because of their dependency from claim 35.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-11, 17-44 and 50-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary et al (O'Leary hereinafter, US PAT: 6,609,113).

Re claim 1. O'Leary discloses a method for making on-line payments (see col.4 lines 36-65), comprising: receiving enrollment information from a user for an on-line payments service (see col.19 lines 11-25, also see col.23 line 65- col.24 line 25); receiving the user's designation of a source account for withdrawing funds for the on-line payments (see col.27 lines 1-15, also see "The user then provides the following information: the source'of the funds--checking, credit card, savings, etc.; the dollar amount of the transfer; the funding date; and whether this is one time transfer or a repeat transfer, col.27 lines 4-15; providing a transaction account for the user as a money deposit account with an account number that the user can use

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as a source and a destination of funds and with at least one of a plurality of service levels (i.e., IPA account, see the abstract); wherein providing the transaction account for the user with at least one of the plurality of service levels further comprises providing the transaction account for the user with a first level service that includes an on-line person-to-person payment service enabling the user to receive and send funds from the user's transaction account (i.e., IPA account, see the abstract, also col.15 lines 35-45), with a save for later feature enabling the user to accumulate a balance of funds in the user's transaction account for later use (see col.11 lines 62-66, see col.21 lines 15-20) and with a held money feature for retaining funds in the user's transaction account which the user has designated to be sent to a recipient but which has not yet been picked up by the recipient (i.e., this is an inherent feature, since funds designated to be sent is normally held against the payer's account until the funds clear or picked up); providing the transaction account for the user with a second level of service that includes all features of the first level of service plus an access card enabling the user to access funds in the user's transaction account for off-line transactions (see fig.4,also see col.21 lines 15-30); allowing the user to have funds reside in the transaction account (see col.11 lines 63-67); and allowing the user to use the funds residing in the transaction account for at least one of making an on-line payment with funds in the transaction account, making an online purchase with funds in the transaction account, making an off-line purchase with funds making a credit

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card account payment with funds in the transaction account, making a bill payment with funds in the transaction account (see col.15 lines 32-45), and making an international payment with funds in the transaction account (i.e., pay anyone virtually anywhere, see col.4 lines 44-46). O'Leary does not explicitly disclose providing the transaction account for the user with a third level of service that includes all features of the first and second levels of service plus a credit line enabling the user to access both line of credit funds and accumulated balance funds in the user's transaction account. However, official notice is taken that attaching a line of credit to a transaction account is old and well known in the art, such method is well established in commercial banking where regular checking transaction account is tied to overdraft line of credit, enabling customers to overdraft their regular transaction accounts if there is an insufficient fund in the said account to settle a payment. Thus it would have been obvious to one of ordinary skill in the art to incorporate the old and well-known feature discussed hereinabove into O'Leary to allow funds to be drawn from customer's transaction account even if there is an insufficient fund in the said account to settle a payment.

Re claims 2, 3. O'Leary further discloses the method, wherein receiving the enrollment information further comprises receiving the information from the user on an enrollment page for the on-line payments service (see col.19 lines 11-25, also see col.23 line 65-col.24 line 25).

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Re claims 4, 5. O'leary further discloses the method, wherein receiving the enrollment information further comprises receiving information about the user necessary to enable the financial institution to validate that the user is bona fide (see fig.10 element 205, also col.27 lines 30-39).

Re claim 6. O'Leary further discloses the method, wherein receiving the user's designation of the source account further comprises receiving the user's designation of at least one of a credit card account and a deposit account of the user as the source account (see col.27 lines 1-15, also see "The user then provides the following information: the source'of the funds--checking, credit card, savings, etc.; the dollar amount of the transfer; the funding date; and whether this is one time transfer or a repeat transfer, col.27 lines 4-15).

Re claims 7, 8. O'Leary further discloses the method, wherein receiving the user's designation of the credit card account as the source account further comprises receiving information from the user about the credit card account consisting of a credit card number, a credit card expiration date, and a credit card (see col.5 lines 40-50, also see col.27 lines 1-15).

Re claims 9, 10. O'leary further discloses the method, wherein receiving the user's designation of the deposit account as the source account further comprises receiving the user's designation of the deposit account consisting of a least one of

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a checking account, a debit account, and a money market account of the user as the source account (see col.27 lines 1-15, also see "The user then provides the following information: the source of the funds--checking, credit card, savings, etc.; the dollar amount of the transfer; the funding date; and whether this is one time transfer or a repeat transfer, col.27 lines 4-15)

Re claim 11. O'Leary further discloses the method, wherein receiving the information about the deposit account further comprises performing a back end validation to confirm that the user is the owner of the designated deposit account (i.e., certification, see fig.10 element 205, also see col.27 lines 30-39).

Re claim 17. O'leary further discloses the method, wherein providing the transaction account for the user that includes the access card further comprises providing the access card for the user that allows the user to withdraw funds from the transaction account at a financial transaction terminal (see fig.4, also see col.21 lines 15-30).

Re claim 18. O'Leary further discloses the method, wherein allowing the user to have funds reside in the transaction account further comprises allowing the user to utilize the transaction account as a hub for user transactions (see the abstract).

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Re claim 19. O'Leary further discloses the method, wherein allowing the user to utilize the transaction account as the hub further comprises allowing the user to use the transaction account for receiving a person-to-person payment (i.e., pay anyone, see abstract).

Re claim 20. O'Leary further discloses the method wherein allowing the user to utilize the transaction account as the hub further comprises allowing the user to fund the transaction account with funds withdrawn from the designated source account (see col.27 lines 1-15).

Re claims 21 and 22. O'leary further discloses the method, wherein allowing the user to fund the transaction account with funds withdrawn from the designated source account further comprises allowing the user to fund the transaction account with funds withdrawn from at least one of a credit card account and a deposit account as the source account (see col.27 lines 1-15).

Re claim 23. O'Leary further discloses the method, wherein allowing the user to have funds reside in the transaction account further comprises allowing the user to have funds reside in at least one of a save for later portion and a held money portion of the transaction account (see col.11 lines 62-66, see col.21 lines 15-20).

Re claim 24. O'leary further discloses the method, wherein allowing the user to have funds reside in at least one of the save for later portion and the held money portion of the transaction account further comprises allowing the user to view

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balances of the save for later and held money portions of the transaction account (see col.15 lines 38-45).

Re claim 25. O'Leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making an on-line payment further comprises designating funds in the transaction account for an on-line payment to a recipient according to an instruction by the user (see the abstract).

Re claim 26. O'Leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making an on-line purchase further comprises allowing the user to transaction account by furnishing the on-line merchant the transaction account number (see the abstract)

Re claim 27. O'Leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making an off-line purchase further comprises allowing the user to authorize payment to an off-line merchant for an off-line transaction with funds in the transaction account using a transaction card provided to the user in connection with the transaction account (see col.22 lines 20-30).

Re claim 28. O'leary further discloses the method wherein allowing the user to use the funds in the transaction account for a cash withdrawal further comprises allowing the user to withdraw funds in cash from the transaction account at a self-service financial transaction terminal using a transaction card provided to the user in connection with the transaction account (see col.21 lines 1-65).

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Re claim 29. O'leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making a credit card account payment further comprises allowing the user to authorize a payment to the user's credit card account with funds in the transaction account according to an instruction by the user (see the abstract).

Re claim 30. O'leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making a bill payment further comprises allowing the user to authorize the bill payment through a bill payment service with funds in the transaction account according an instruction by the user (see col.15 lines 31-45).

Re claims 31, 70. O'Leary further discloses the method, wherein allowing the user to use the funds in the transaction account for making an international payment further comprises allowing the user to authorize the international payment through an international payment service with funds in the transaction account according an instruction by the user (i.e., O'Leary system can pay anyone virtually anywhere, see col.4 lines 40-50).

Re claim 32. O'leary further discloses the method, wherein allowing the user to use the funds in the transaction account further comprises allowing the user to utilize a save for later portion of the funds in the transaction account (see col.11 lines 62-66, see col.21 lines 15-20).

Re claim 33. O'leary does not explicitly disclose the method wherein transaction account further comprises allowing the user to supplement the save

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for later portion of the funds in the transaction account with a line of credit associated with the transaction account. However, official notice is taken that attaching a line of credit to a transaction account is old and well known in the art, such method is well established in commercial banking where regular checking transaction account is tied to overdraft line of credit, enabling customers to overdraft their regular transaction accounts if there is an insufficient fund in the said account to settle a payment. Thus it would have been obvious to one of ordinary skill in the art to incorporate the old and well-known feature discussed hereinabove into O'Leary to allow funds to be drawn from customer's transaction account even if there is an insufficient fund in the said account to settle a payment.

Re claim 34. Claim 34, though a system claim, recites similar limitations to a method claim 1 supra, and thus rejected using the same art and rationale as in claim 1 supra.

Re claims 35, 36. O'Leary further discloses the system, wherein the means for receiving the enrollment information further comprises means for receiving the information from the user on an enrollment page for the on-line payments service (see col.19 lines 11-25, also see col.23 line 65-col.24 line 25).

Re claims 37, 38. O'leary further discloses the system, wherein the means for receiving the enrollment information further comprises means for receiving

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information about the user necessary to enable the financial institution to validate that the user is bona fide (see fig.10 element 205, also col.27 lines 30-39).

Re claim 39. O'Leary further discloses the system, wherein the means for receiving the user's designation of the source account further comprises means for receiving the user's designation of at least one of a credit card account and a deposit account of the user as the source account account (see col.27 lines 1-15, also see "The user then provides the following information: the source'of the funds--checking, credit card, savings, etc.; the dollar amount of the transfer; the funding date; and whether this is one time transfer or a repeat transfer, col.27 lines 4-15).

Re claims 40, 41. O'leary further discloses the system, wherein the means for receiving the user's designation of the credit card account as the source account further comprises means for number, a credit card expiration date, and a credit card verifier (see col.5 lines 40-50, also see col.27 lines 1-15).

Re claims 42, 43. O'Leary further discloses the system, wherein the means for receiving the user's designation of the deposit account as the source account further comprises means for receiving the user's designation of the deposit account consisting of a least one of a checking account, a debit account, and a money market account of the user as the source account (see col.27 lines 1-15, also see "The user then provides the following information:

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the source'of the funds--checking, credit card, savings, etc.; the dollar amount of the transfer; the funding date; and whether this is one time transfer or a repeat transfer, col.27 lines 4-15.

Re claim 44. O'Leary further discloses the means for receiving the information about the deposit account further comprises means for performing a back end validation to confirm that the user is the owner of the designated deposit account (i.e., certification, see fig.10 element 205, also see col.27 lines 30-39).

Re claim 50. O'Leary further discloses the system, wherein the means for providing the transaction account for the user that includes the access card further comprises means for providing the access card for the user that allows the user to withdraw funds from the transaction account at a financial transaction terminal (see fig.4, also see col.21 lines 15-30).

Re claim 51. O'Leary further discloses the system, wherein the means for allowing the user to have funds reside in the transaction account further comprises means for allowing the user to utilize the transaction account as a hub for user transactions (see the abstract).

Re claim 52. O'Leary further discloses the system wherein the means for allowing the user to utilize the transaction account as the hub further comprises means for allowing the user to use the trust account for receiving a person-to-person payment (i.e., pay anyone, see the abstract).

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Re claim 53. O'leary further discloses the system, wherein the means for allowing the user to utilize the transaction account as the hub further comprises means for allowing the user to fund the transaction account with funds withdrawn from the designated source account (see col.27 lines 1-15).

Re claims 54, 55. O'Leary further discloses the system, wherein the means for allowing the user to fund the transaction account with funds withdrawn from the designated source account further comprises means for allowing the user to fund the trust account with funds withdrawn from at least one of a credit card account and a deposit account as the source account (see col.27 lines 1-15).

Re claim 56. O'Leary further discloses the system, wherein the means for allowing the user to have funds reside in the transaction account further comprises means for allowing the user to have funds reside in at least one of a save for later portion and a held money portion of the transaction account (see col.11 lines 62-66, see col.21 lines 15-20).

Re claim 57. O'Leary further discloses the system, wherein the means for allowing the user to have funds reside in at least one of the save for later portion and the held money portion of the transaction account further comprises means for allowing the user to view balances of the save for later and held money portions of the transaction account (see col.15 lines 38-45).

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Re claim 58. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for making an on-line payment further comprises means for to an instruction by the user (see the abstract).

Re claim 59. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for making an on-line purchase further comprises means for allowing the user to authorize payment to an on-line merchant for an on-line transaction with funds in the transaction account by furnishing the on-line merchant the transaction account number (see the abstract).

Re claim 60. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for making an off-line purchase further comprises means for allowing the user to authorize payment to an off-line merchant for an off-line transaction with funds in the transaction account using a transaction card provided to the user in connection with the transaction account (see col.22 lines 20-30).

Re claim 61. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for a cash withdrawal further comprises means for allowing the user to withdraw funds in cash from the transaction account at a self-service financial transaction terminal using a transaction card provided to the user in connection with the transaction account (see col.21 lines 1-65).

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Re claim 62. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for making a credit card account payment further comprises means for allowing the user to authorize a payment to the user's credit card account with funds in the transaction account according to an instruction by the user (see the abstract).

Re claim 63. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account for making a bill payment further comprises means for allowing the user to authorize the bill payment through a bill payment service with funds in the transaction account according to an instruction by the user (see col.15 lines 31-45).

Re claim 64. O'Leary further discloses the system wherein the means for allowing the user to use the funds in the transaction account for making an international payment further comprises means for allowing the user to authorize the international payment through an international payment service with funds in the transaction account according to an instruction by the user (i.e., O'Leary system can pay anyone virtually anywhere, see col.4 lines 40-50).

Re claim 65. O'Leary further discloses the system, wherein the means for allowing the user to use the funds in the transaction account further comprises means for allowing the user to utilize a save for later portion of the funds in the transaction account (see col.11 lines 62-66, see col.21 lines 15-20).

Re claim 66. O'Leary does not explicitly disclose the system, wherein the means for allowing the user to use the funds in the transaction account further comprises means for allowing the user to supplement the save for later portion of the funds in the transaction account with a line of credit associated with the transaction account. However, official notice is taken that attaching a line of credit to a transaction account is old and well known in the art, such method is well established in commercial banking where regular checking transaction account is tied to overdraft line of credit, enabling customers to overdraft their regular transaction accounts if there is an insufficient fund in the said account to settle a payment. Thus it would have been obvious to one of ordinary skill in the art to incorporate the old and well-known feature discussed hereinabove into O'Leary to allow funds to be drawn from customer's transaction account even if there is an insufficient fund in the said account to settle a payment.

Re claim 67. O'Leary further discloses the method, wherein receiving the user's designation of a source account for withdrawing funds for the on-line payments further comprises receiving the user's designation of a credit card account and designating the withdrawn funds as a purchase on the credit card account by a payments engine (see col.5 lines 40-50).

Re claim 68. O'Leary further discloses the method, wherein allowing the user to use the funds in the transaction account *for* making an on-line payment further comprises: receiving an email address and payment amount by a payments engine for a recipient

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from the user at a user terminal via a network; notifying the recipient by email at a recipient terminal by the payments engine of the payment (i.e., payment confirmation see col.16 lines 35-65); prompting the recipient by the payments engine to enroll for the on-line payments service (see col.23 lines 45-67); recipient account to receive the payment and applying the payment amount to the recipient account by the payments engine; and if the recipient declines to enroll, arranging a courtesy check for the payment amount to the recipient by the payments engine (see col.24 lines 22-50).

Re claim 69. O'Leary further discloses the method, wherein receiving the recipient's designation of a recipient account and applying the payment amount to the recipient account further comprises receiving the recipient's designation of a recipient credit card account and applying the payment amount as a payment on the recipient credit card account (see col.27 lines 1-15).

Re claims 71 and 72. Claims 71 and 72 recite similar limitations to claim 1 supra, and thus rejected using the same art and rationale as in claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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